

REMARKS

Claims 1-2, 6-9 and 11-17 are pending in the above-identified application. Support for the changes to claim 1 is found, for example, at pages 20-21, as well as page 15, of the present specification. Otherwise, the claims have been amended so as to correspond to the modifications of claim 1.

Request for Acknowledgement of Information Disclosure Statement

An Information Disclosure Statement (IDS) was filed on January 31, 2007 and a copy of thereof is enclosed herewith. It is respectfully requested that the Patent Examiner acknowledge receipt of this IDS and issue an appropriate initialed SB/08 Form to confirm that the listed reference was properly considered by the Examiner.

Removal of Issue under 35 USC 112

Claims 1-3 and 6-18 were rejected under 35 USC 112, second paragraph, as alleging being indefinite based on the reasons indicated at the top of page 2 of the Office Action of January 24, 2007. Claims 1 and 17 have been corrected so as to remove the problems identified in the Office Action. Claims 18 has been cancelled. Consequently, it is requested that this rejection be withdrawn.

Issues under 35 USC 103(a)

Claims 1-3, 6-10, 12-16 and 18 have been rejected under 35 USC 103(a) as being unpatentable over Vreeland '001 or '457 (USP 5,541,001; USP 5,571,457) or Gloyer '576 (U.S. 2001/0046576) each in view of Barksby '445 (U.S. Patent 6,420,445) and Knobel '669 (U.S. Patent 5,110,669).

Claims 1-3, 6-10 and 12-19 have been rejected under 35 USC 103(a) as being unpatentable over Vreeland '001 or '457 or Gloyer '576, each in view of Barksby '445 and further in view of Wen

'897 or '639 (USP 6,077,897 or USP 6,159,639) or Sandlin '451 (USP 6,093,451) or Noh '002 (US 2002/0042002).

Claim 11 has been rejected under 35 USC 103(a) as being unpatentable over the same references as indicated in the first-listed rejection in this section, and further in view of Nogami '646 (USP 5,618,646) or Priebe '188 (USP 5,869,188).

Claims 11 has additionally been rejected under 35 USC 103(a) as being unpatentable over all of the references listed in the second-listed rejection of this section, and further in view of Nogami '646 and Priebe '188.

All of the above-noted rejections are respectfully traversed based on the following reasons.

Distinctions over Cited References

The present invention is directed to a conductive roller formed from a conductive urethane composition and a metal shaft, wherein the composition is formed from polyurethane obtained by a poly-addition reaction of a polyol and polyisocyanate in a specified amount, and the composition contains a metal salt of a bis(fluoroalkyl-sulfonyl)imide.

All of the above-cited references fail to disclose or suggest a conductive roller formed from a polyurethane composition that is formed using a polyisocyanate in the specified amount together with the imide metal salt. Thus, all of these references fail to recognize the advantages exhibited by the present invention with respect to improved surface roughness, stain resistance properties, and image printing quality as evidenced by the comparative test results summarized in Tables 1-3 at pages 24-40 of the specification.

All of the cited references fail to establish *prima facie* obviousness of a claimed invention, since all of the claim elements are not disclosed. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143, Rev. 5, Aug. 2006, p. 2100-126. Even if *prima facie* obviousness has

been properly alleged, such obviousness has been rebutted by the comparative test results discussed above. Consequently, all of the above-noted rejections should be withdrawn.

It is submitted for the reasons above that the present claims define patentable subject matter such that this application should now be placed in condition for allowance.

If any questions arise in the above matters, please contact Applicant's representative, Andrew D. Meikle (Reg. No. 32,868), in the Washington Metropolitan Area at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: April 24, 2007

Respectfully submitted,

By 
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